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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/704,864 | 11/02/2000 | Thomas J. Foth | F-206 | 5186 |

919 7590 10/03/2003

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| EXAMINER |
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ELISCA, PIERRE E

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| ART UNIT | PAPER NUMBER |
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3621

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/704,864

Applicant(s)

Thomas J. Foth et al.

Examiner

Pierre E. Elisca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/22/2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Examiner Pierre Eddy Elisca

United States Department of Commerce

Patent and Trademark Office

Washington, D.C. 20231



DETAILED ACTION

1. This Office action is in response to Applicant's amendment, filed on 08/22/2003.
2. Claims 1-19 are pending.

Claim Rejections - 35 USC § 102 (b)

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 (b) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-19 are rejected under 35 U.S.C. 102 (b) as being anticipated by Stefik et al. (U.S. Pat. No. 5,638,443).

As per claims 1, 12, 14-16, and 18-19 Stefik discloses a system/method for controlling use and distribution of composite digital works (which is readable as Applicant's claimed invention wherein it is stated that a method for handling material) the method comprising:

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obtaining digital rights management protected material for a consumer (see., abstract, specifically wherein it is stated that composite digital work by examining the usage rights for each individual digital work);

informing a bookshelf that the protected material was obtained (see., abstract, col 4, lines 15-32, specifically wherein it is stated that access is granted if the composite digital work if access to each of the individual digital works can be granted, col 5, lines 43-67, and col 6, lines 36-48, please note that bookshelf is readable as tree structure);

determining whether or not there is a existing copy of the protected material (see., col 3, lines 50-67, col 4, lines 1-32, col 1, lines 25-59);

storing an existing copy of the protected material (or digital work) automatically of archival purposes at a site remote from the consumer at the time the material was first obtained by the consumer (see., abstract, col 4, lines 1-32, col 1, lines 25-59, specifically wherein it is stated that the content part stores the actual digital data comprising the composite digital work. A description part is logically organized in a acyclic structure (e.g. a tree structure). The description part may naturally be stored separately on a separate medium from the content part. The composite digital works are stored in repositories, and also, col 3, lines 50-67, copy or distribution of digital work . Please note that the content part, description part of the digital work are stored at a site from the consumer);

creating a pointer for the consumer to point to the stored archival material (see., abstract, specifically wherein it is stated that a node in the acrylic structure is comprised of an identifier of the individual work, usage rights for the individual digital work and a pointer to the digital work, and col 4, lines

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9-14). Stefik further discloses a clearinghouse see., fig 3, item 303, col 17, lines 36-48, specifically repository 201 or archival is connected to clearinghouse.

As per claims 2, 4, Stefik discloses the claimed method wherein the existing copy of the protected material is obtained from the provider of the material (provider of the material or owner of an individual digital work) see., col 3, lines 50-67, specifically wherein it is stated that the owner of an individual work to attach usage rights (usage rights or copy of the protected material) to their work.

As per claim 3, Stefik discloses the claimed method wherein the existing copy of the protected material is obtained from the vendor (vendor or owner) of the material or digital work (see., col 3, lines 50-67, specifically wherein it is stated that the owner of an individual work to attach usage rights (usage rights or copy of the protected material) to their work, and also col 4, lines 1-31).

As per claims 5, 8, 9, 13, and 17 Stefik discloses the claimed method wherein the pointer is located in a bookshelf (see., abstract, col 4, lines 9-14).

As per claims 6, and 7 Stefik discloses the claimed method of transferring the consumer's rights to the material to a third party (see., fig 1, item 105 or third party, digital work to determine if access may be granted , and also col 2, lines 1-23, col 4, lines 15-32).

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As per claims 10, an 11 Stefik discloses the claimed method of transferring a portion of the consumer's rights to the material to a third party (see., fig 7, item 701 that has two parts, a first part is a unique number assigned to the repository or portion of the consumer's rights, and a second part is a unique number assigned to the work upon creation, and therefore, it is inherent to realize that the first part or portion is a unique number for consumer's rights, col 9, lines 1-14).

NOTE

5. The claimed bookshelf recited in claim 1 when viewed in light of the specification, particularly pages 6-9, figs 3-5 is being defined as an electronic bookshelf. The claimed bookshelf encompasses a physical or device being within the technological arts and thus claim 1 taken as a whole constitutes a concrete, a useful, and a tangible result.

RESPONSE TO ARGUMENTS

6. Applicant's arguments filed on 08/22/2003 have been fully considered but they not persuasive.

REMARKS

7. In response to Applicant's arguments, Applicant argues that the prior art of record taken alone or in combination fails to disclose: “

a. “creating a pointer for the consumer to point to the stored archival material”. As stated above, Stefik discloses in the abstract that a node in the acrylic structure is comprised of an identifier of the

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individual work, usage rights for the individual digital work and a pointer to the digital work, and col 4, lines 9-14). Applicant should duly note that Stefik's pointer points to the digital work or archival material.

b. " automatically making an archival copy of the protected material at a site remote form the consumer". However, the Examiner respectfully disagrees since Stefik discloses a content part that stores the actual digital data comprising the composite digital work. A description part is logically organized in a acyclic structure (e.g. a tree structure). The description part may naturally be stored separately on a separate medium from the content part. The composite digital works are stored in repositories, and also, col 3, lines 50-67, copy or distribution of digital work (usage rights of digital work or protected material) , see., abstract, col 4, lines 1-32, col 1, lines 25-59. Please note that the content part, description part of the digital work are stored at a remote site from the consumer (at a remote site or repositories)

Conclusion

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the

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date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication from the examiner should be directed to Pierre Eddy Elisca at (703) 305-3987. The examiner can normally be reached on Tuesday to Friday from 6:30AM. to 5:00PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of patents and Trademarks

Washington, D.C. 20231

The Official Fax Number For TC-3600 is:

(703) 305-7687


Pierre Eddy Elisca

Patent Examiner

September 29, 2003